

the Examiner to contain claims 1-11. The Applicants elected claims 1 – 11 as allowed by the Examiner and further elected the species of claim 15 in their July 25, 2003 response to the Examiner's election of species requirement. The Applicants respectfully request that the Examiner correct this oversight and identify as currently pending all of claims 1-11 as allowed and elected in the Applicants response to the Restriction Requirement.

The Examiner has rejected claims 1-6 (sic) and 15 as being unpatentable over Bay et al., WO 00/59863, Leone-Bay et al., '536 or Leone-Bay et al., '647 taken with GB 2295966 or WO 0057857, and Purkayastha et al or EP 438147. The Applicants respectfully disagree with the rejection and request that the Examiner withdraw the rejection of claims 1-11 and 15 based thereon for the following reasons.

The Applicants have added claim 16 to highlight the ranges of the elected species that have been determined by the Applicant to contribute to the non-obvious nature of the present invention. Support for claim 16 may be found on page 4 lines 14-15 and lines 29-32 and also on page 7 lines 1-2 of the Specification.

Claim 16 reflects the solid pharmaceutical composition of the present invention. Example 1 provides various examples of ways to prepare the present invention. Examples 2 – 5 provide evidence of the use and performance of the present invention. It can not be assumed that merely because individual elements of the present invention have been disclosed in the prior art, that the combination of the specific active and inactive ingredients of the present invention could be have been predicted to show the stability, disintegration and bioavailability of the present invention as evidenced in Examples 2 – 6. Claim 16 more fully highlights the ranges of the non-optional elected elements which have been shown to be novel and non-obvious in the Examples of the present invention.

The Applicants further assert that one skilled in the art could not have predicted that the combination of elements and the specific active agent salmon calcitonin, as used in the present application, would have the properties shown in the present invention. There is no motivation in the prior art references cited by the Examiner to combine the inactive ingredients and salmon calcitonin as claimed in the present invention. It is obvious to try to combine elements disclosed in the prior art but there is no suggestion or motivation to combine the elements in the proportions and manner as the Applicants have done. It is not appropriate "to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of

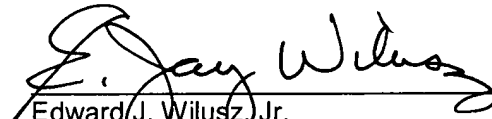
other parts necessary to the full appreciation of what the reference fairly suggests to one skilled in the art." In re Wesslau, 353 F. 2d at 241, 147 U.S.P.Q. at 393 (C.C.P.A. 1965). The Applicants therefore respectfully request that the Examiner withdraw the rejection of claims 1-11 and 15.

The Applicants believe that the application is in condition for allowance and respectfully request early notice to that effect.

If it will advance prosecution of the case the Examiner is urged to telephone the Applicants' undersigned counsel at the number listed below.

Respectfully submitted,

Novartis
Corporate Intellectual Property
One Health Plaza, Building 430
East Hanover, NJ 07936-1080
(862) 778-7960


Edward J. Wilusz, Jr.
Attorney for Applicant
Reg. No. 52,370

Date: February 20, 2004